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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/669,578

09/23/2003

Jeffrey A. Kusnitz

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SUITE 3020

BOCA RATON, FL 33487

EXAMINER

ADDY, THUAN KNOWLIN

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

05/26/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/669,578	KUSNITZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	THJUAN K. ADDY	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-16 and 36-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 and 36-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/30/2009</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed on April 29, 2009 has been entered. Claim 9 has been amended. Claims 1-8 and 17-35 have been cancelled. Claims 36-45 have been added. Claims 9-16 and 36-45 are now pending in this application, with claims 9, 36, and 39 being independent.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/29/2009 has been entered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9-16 and 36-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diacakis (US Patent Application, Pub. No: US 2003/0174814 A1), in view of Aravamudan et al. (US 6,301,609).

4. In regards to claims 9, 36, and 39, Diacakis discloses a method, telephone, and computer-readable tangible medium embodying computer-readable program code, within a telephone (See Fig. 1, wireless telephone 9 or landline telephone 8), for controlling the telephone having a first connection to a packet switched network (See Fig. 1 and IP Network 16) and a second connection to a circuit-switched telephone network (See Fig. 1 and telephone network/PSTN 14), the method comprising storing multiple identifications (e.g., presence/location) for an entity (e.g., individual/recipient) selectable by a user (e.g., subscriber/caller) of the telephone, that can be called from the telephone, storing telephone numbers (e.g., work number, home number, and wireless telephone number) associated with the entity (See pg. 3, paragraph [0036]), receiving, from the packet switched network (via presence server 24, See Fig. 1), presence indicators associated with at least some of the telephone numbers, storing the presence indicators in association with corresponding telephone numbers, and responsive to a selection of an entity by a user, selecting a number for dialing based on

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the state of the presence indicators associated with the selected entity (See pg. 3, paragraph [0032] and pg. 4, paragraph [0038]). Diacakis, however, does not disclose wherein the first connection is separate from the second connection. Aravamudan, however, does disclose wherein the first connection (See Fig. 1-2 and packet routing/switching module 122) is separate from the second connection (See Fig. 1-2 and PSTN switching module 124) (See col. 3 lines 26-44 and col. 9-10 lines 64-15). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate this limitation within the method, as a way of allowing communications and data to be bi-directionally exchanged between a client's device(s) (i.e., such as wireless cellular phone 150) and a service provider via a PSTN switching module and/or a packet routing/switching module.

5. In regards to claims 10, 37, and 40, Diacakis discloses the method, telephone, and computer-readable tangible medium, further comprising selectively placing calls over the circuit-switched telephone network or over the packet-switched network (See pg. 2, paragraph [0022] – [0023]).

6. In regards to claims 11, 38, and 41, Diacakis discloses the method, telephone, and computer-readable tangible medium, wherein the telephone comprises a base station (e.g., associated with MSC 18, See Fig. 1) having connections to the circuit-switched network and to the packet-switched network and a mobile device (See Fig. 1 and wireless telephone 9) that communicates with the base station using wireless protocols (See Fig. 1 and pg. 2, paragraph [0022]).

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7. In regards to claims 12 and 42, Diacakis discloses the method and computer-readable tangible medium, wherein the step of storing telephone numbers further comprises storing at the base station the identification of the entity, the telephone numbers associated with the entity and the presence indicators, and storing at the mobile device the names of the entities, and the method further comprises transmitting a name of the selected entity to the base station (See pg. 3, paragraph [0036] and pg. 4, paragraph [0038]).

8. In regards to claims 13 and 43, Diacakis discloses the method and computer-readable tangible medium, further wherein the step of placing calls further comprises routing a call to the circuit-switched network or to the packet-switched network according to a user preference associated with the selected number (See pg. 2, paragraph [0028] and pg. 4, paragraph [0038]).

9. In regards to claims 14 and 44, Diacakis discloses the method and computer-readable tangible medium, further comprising storing user routing preferences based on time-of-day (See pg. 6, paragraph [0056]).

10. In regards to claims 15 and 45, Diacakis discloses all of claims 15 and 45 limitations, except the method, further comprising storing user routing preferences based on an area code of the selected number. Diacakis, however, does disclose the method, further comprising storing user routing preferences based on time-of-day (See pg. 6, paragraph [0056]). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate this feature within the system and

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method, as a way of further defining routing preferences of a user, in relations to a selected/specific number.

11. In regards to claim 16, Diacakis discloses the method, further comprising the steps of determining if additional numbers are stored for the called entity responsive to an unanswered telephone call and re-trying a call to such an additional telephone number (See pg. 3, paragraph [0032]).

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 9-16 and 36-45 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to THJUAN K. ADDY whose telephone number is (571)272-7486. The examiner can normally be reached on Mon-Fri 8:30-5:00pm.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thjuan K. Addy/  
Primary Examiner, Art Unit 2614